

APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 10/687,875
Attorney Docket No. 042013-0311336 (23446-016-401)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Dominick Cirone
SERIAL NO.: 10/687,875
ATTORNEY DOCKET NO: 042013-0311336 (234)
FILING DATE: October 20, 2003
ART UNIT : 3727
EXAMINER: TRI M. MAI
FOR: PROTECTIVE BAT COV

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Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the “*Notification of Non-Compliance*” mailed December 30, 2004, Appellant submits a new Brief on Appeal pursuant to 37 C.F.R. §41.37.

It is believed that no fees are due in connection with the filing of this new Appeal Brief. In the event that it is determined that fees are due, however, the Director is hereby authorized to charge the undersigned's Deposit Account No. 033975 (**Ref. No. 042013-0311336**).

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Before addressing each of the requirements of 37 C.F.R. §41.37, Appellant offers the following Preliminary Statement.

PRELIMINARY STATEMENT

Appellant's invention relates to a protective bat cover for use with bats (*e.g.*, baseball or softball bats) having a barrel portion and a handle portion. In particular, the protective bat cover, as disclosed and claimed by Appellant, includes a combination of features that address *at least* three problems or drawbacks with existing bat covers.

A first feature of Appellant's protective bat cover is that it includes a lightweight, flexible, and easy to use material (*e.g.*, neoprene) that provides increased protection for the barrel of a bat. By forming the protective bat cover from neoprene (an elastic rubber material), the barrel of a bat may be protected from both harmful environmental conditions (*e.g.*, temperature and moisture) and damage resulting from inadvertent contact with various other objects, thus increasing the life span of a bat. The insulative properties of neoprene serve to increase the range of temperatures in which a bat may be used without being damaged. This is particularly advantageous in connection with bats that have temperature-dependent metals.

Appellant's protective bat cover also includes a feature that facilitates placement of the protective bat cover on the barrel of a bat. According to an embodiment, the protective bat cover comprises a substantially tubular casing having one closed end and one open end for receiving the barrel portion of a bat. A seam extends partially along the length of the cover, leaving a split that extends downward into the open end. The provision of a split at the open end of the cover provides various advantages. For

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example, it enables a user to grab either one or both of the two edges of the split, and to pull on it/them to provide assistance in getting the cover on to the bat. Given the desired, relatively tight fit between the neoprene cover and the bat to hold the cover in place once it is on, this feature is particularly simple but effective, yet adds no separate material or other structures to locate the cover on the bat.

A third feature of Appellant's protective bat cover is the provision of a fastening mechanism (e.g., hook and loop fastener) to secure the cover to the barrel of a bat.

The Patent Examiner found no *bat cover* in the bat cover art with this combination of features. To remedy the deficiencies of the bat cover art in general, the Examiner went far afield from the bat cover art and relied on non-analogous art. This non-analogous art individually may disclose bits and pieces of the claimed invention, but such picking and choosing of features from non-analogous art is legally improper. In fact, the Examiner has strung together as many as four references from diverse arts to reject one of Appellant's bat cover claims. In doing so, the Examiner has affirmatively stated that he was ignoring many of the claim elements, erroneously arguing that they were merely statements of intended use. The Examiner's need to string together four non-analogous references, yet still turn a blind eye to positively recited claim elements is very telling with respect to the weakness of the rejections.

For example, for the alleged obviousness rejections under 35 U.S.C. §103(a), the Examiner cites no references from the bat cover art, but rather relies on: (1) a collapsible, insulative beverage container carrier; (2) an attachable baby bottle holder; (3) a combination postcard/container insulator; and (4) a sanitary cover for a shopping cart handle.

Accordingly, as set forth in detail below, Appellant will show that the rejections

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were an exercise of hindsight based on improperly picking and choosing among non-analogous art, with no proper suggestion for combining the relied-upon references. For at least these reasons, each of the rejections should be overturned.

REQUIREMENTS OF 37 C.F.R. §41.37

I. REAL PARTY IN INTEREST - 37 C.F.R. §41.37(c)(1)(i)

The real party in interest is the named sole inventor, Dominick Cirone.

II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii)

Appellant is aware of no related appeals or interferences.

III. STATUS OF CLAIMS - 37 C.F.R. §41.37(c)(1)(iii)

Pending: Claims 19 and 20.

Cancelled: Claims 1-18 have been cancelled.

Rejected: Claims 19 and 20.

Allowed: No claims have been allowed.

On Appeal: Claims 19 and 20 are appealed. Claims 19 and 20 correspond exactly to claims 31 and 33, respectively, that were previously examined in the parent application (U.S. Patent Application Serial No. 09/664,537, filed September 18, 2000, and issued on January 7, 2004 as U.S. Patent No. 6,681,821 B1).

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IV. STATUS OF AMENDMENTS - 37 C.F.R. §41.37(c)(1)(iv)

No amendments have been filed subsequent to the mailing of the Office Action on June 30, 2004 (hereinafter "Office Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 C.F.R. §41.37(c)(1)(v)

Appellant's invention comprises a protective bat cover (10) for use with a bat (*e.g.*, a baseball or softball bat) (6) having a barrel portion (8) and a handle portion. Generally, the barrel portion (8) of the bat (6) is substantially uniform in diameter, while the handle portion has a diameter that is less than the diameter of the barrel portion. *See* Specification, *e.g.*, pg. 5, *ll.* 6-14; and FIG. 1.

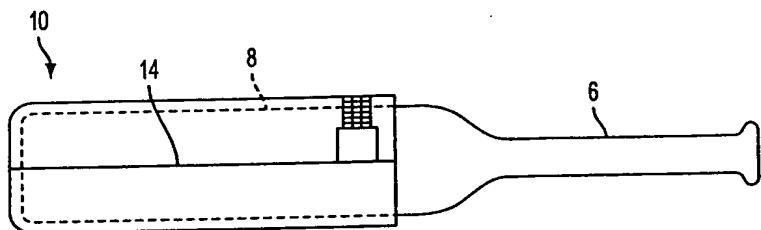


FIG. 1 of U.S. Application Serial No. 10/687,875.

According to an embodiment of the invention, the protective bat cover (10) may be made of an elastic rubber material such as neoprene. *See* Specification, *e.g.*, pg. 5, *ll.* 14-15. One advantage of neoprene is its ability to conform to the shape of the barrel, which enables the cover (10) to be used with various sized bats, and which ensures a secure fit when placed over a bat. The ability of neoprene to flex, as well as its ability to retain the

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“memory” of a barrel shape, allows the protective bat cover to be easily secured to, and removed from bats with a diameter that may even be slightly larger than that of the cover.

Neoprene also exhibits greater weather resistance than less elastic materials such as plastics, leather, nylon, and the like, which tend to be more susceptible to cracking, expansion, and other undesirable effects. This allows the protective bat cover to increase the range of temperatures in which a bat may be used without being damaged. Metal baseball bats, for example, are known to experience a change in properties, often becoming harder in colder temperatures and softer in warmer temperatures. When a bat is used during these periods of hot and cold temperatures, it is likely to be more susceptible to damage (*e.g.*, due to brittleness when cold and softness when hot). A protective bat cover made of neoprene possesses insulative properties that serve to keep a bat warmer in colder temperatures, and vice versa. Simultaneously, it provides a cushioning to minimize dents and other damage. *See Specification, e.g., pg. 5, line 14–pg. 6, line 13.*

According to one embodiment of the invention, with reference to FIG. 2, the first piece of elastic rubber material (*e.g.*, neoprene) has a first edge and an opposing second edge fastened together to form a substantially tubular casing having a first open end for receiving the barrel portion of the bat, and a second end closed off by a second piece of neoprene (elastic rubber) material fastened to the first piece of neoprene material. For example, a first material piece (12) is preferably cut into a generally rectangular shape, having a substantially first straight edge (12a) and a substantially second straight edge (12b).

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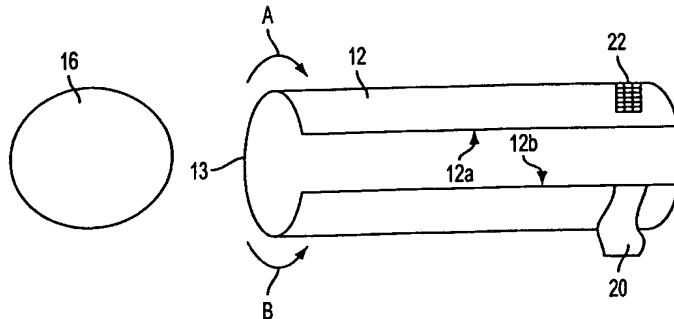


FIG. 2 of U.S. Application Serial No. 10/687,875.

The first and second edges (12a, 12b) may be folded toward one another in the general direction illustrated by arrows A and B (see FIG. 2) and stitched or otherwise fastened together to form a seam (14). As such, first material piece (12) may form a hollow, tubular casing having two open ends. A second material piece (16), preferably cut into the shape of a circle, may then be stitched or otherwise fastened to an open end (13) of the first material piece (12), forming a protective cover (10) having one closed end and one open end (18). *See Specification, e.g., pg. 6, line 14–pg. 7, line 4; and FIGS. 1-3.* The simplicity of the manufacture of the protective cover helps keep costs to a commercially acceptable level.

In one embodiment of the invention, the first edge and opposing second edge of the first piece of neoprene (elastic rubber) material are fastened together only partially along their respective lengths to form a split that begins nearest to and extends into the first open end of the substantially tubular casing. For example, as illustrated in FIG. 5, the first and second edges (12a, 12b) may be fastened together to form a seam (14) that extends only partially along the length of the cover (10), leaving a split that extends toward opening (18).

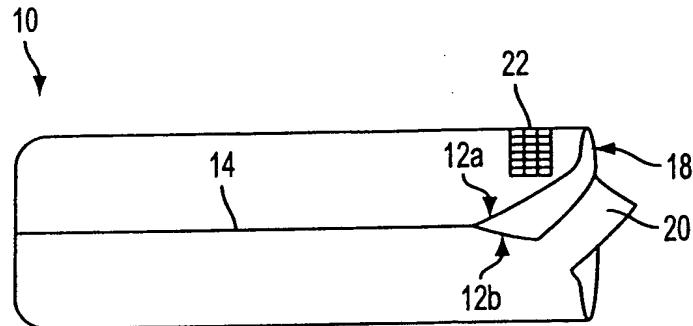


FIG. 5 of U.S. Application Serial No. 10/687,875.

The provision of a split at the open end of cover (10) facilitates the process of placing the cover on the bat. A user, for example, can grab either one or both of the two edges (12a, 12b) of the split and pull on them to provide assistance in getting the cover on to the bat. Also, a split enables the two edges (12a, 12b) to overlap each other when pulled tight and fastened, creating a relative secure attachment of the cover (10) to a bat. *See Specification, e.g., pg. 8, line 11–pg. 9, line 3; and FIGS. 5-6.* This feature provides several benefits as discussed above, without adding any costs for material or separate structures.

According to an embodiment of the invention, the substantially tubular casing further defines an interior cavity of substantially uniform diameter and is adapted to cover substantially only the barrel portion of the bat when the bat is inserted into the interior cavity such that an end of the barrel portion abuts the closed second end of the substantially tubular casing. *See FIG. 1.*

According to an embodiment of the invention, fastening means may be mounted on the substantially tubular casing adjacent to the open end for securing the cover to the barrel portion of bat. For example, a fastening mechanism may also be provided with the protective bat cover (10), such as a hook and loop fastener (more commonly known as

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VELCROTM). In alternative embodiments, strips having button snaps or other fastening mechanisms may also be used. *See Specification, e.g., pg. 7, line 15 – pg. 8, line 5; and FIGS. 2, & 4-6.*

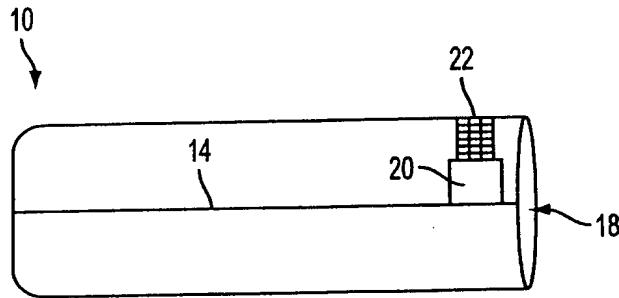


FIG. 4 of U.S. Application Serial No. 10/687,875.

According to an embodiment of the invention, a graphic may be displayed on the substantially tubular casing between the closed end and the fastening means. For example, as illustrated in FIG. 3, the (substantially uninterrupted) surface area of the protective cover (10) facilitates the prominent display of a team name, company name, team logo, graphic, or other design, especially in instances when the protective cover is being viewed from a distance. *See Specification, e.g., pg. 3, ll. 15-19; pg. 8, ll. 9-11; and FIG. 3.*

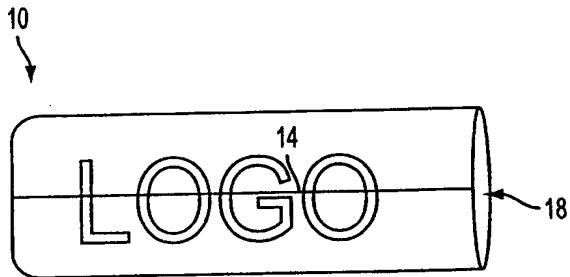


FIG. 3 of U.S. Application Serial No. 10/687,875.

A method for using the protective bat cover is also disclosed. In one embodiment, to use the protective cover (10), a user may slip the barrel portion (8) of the bat (6) into the opening (18) of the cover, and then pull the cover down over the barrel of the bat,

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preferably as far as possible. Strap (20) may then be fastened to strip (22) in order to further secure the cover to the bat. *See* Specification, *e.g.*, pg. 8, *ll.* 6-11; and FIGS. 1 & 4. The ease of covering and uncovering the bat is also an advantage of the invention.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL - 37 C.F.R. §41.37(c)(1)(vi)

A. Claim 19 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,401,245 to Zills, in view of U.S. Patent No. 4,989,811 to Millis *et al.* (“Millis”). *See* Office Action, pg. 2, ¶3.

B. Claim 20 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of U.S. Patent No. 4,401,245 to Zills and U.S. Patent No. 4,989,811 to Millis *et al.* (“Millis”), further in view of U.S. Patent No. 5,163,608 to Block, or U.S. Patent No. 6,065,764 to Moseley. *See* Office Action, pg. 3, ¶4.

Appellant notes the rejection of claims 19 and 20 under the judicially created doctrine of obviousness-type double patenting. *See* Office Action, pg. 2, ¶’s 1-2. Although Appellant disagrees with the rejections set forth by the Examiner, Appellant will not address these rejections in the Appeal Brief. Rather, Appellant will consider filing a terminal disclaimer upon the indication of allowable subject matter. Appellant further notes that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.” *See* MPEP §804.02.

VII. ARGUMENTS - 37 C.F.R. §41.37(c)(1)(vii)

Each rejection should be reversed for the reasons set forth herein.

A. Summary of the Alleged Prior Art Relied on in the Art Rejections.

1. U.S. Patent No. 4,401,245 to Zills.

U.S. Patent No. 4,401,245 to Zills is directed to a *beverage container carrier* that is insulated to maintain a constant beverage temperature, and is foldable for compact storage. *See* "TECHNICAL FIELD," col. 1, ll. 5-10.

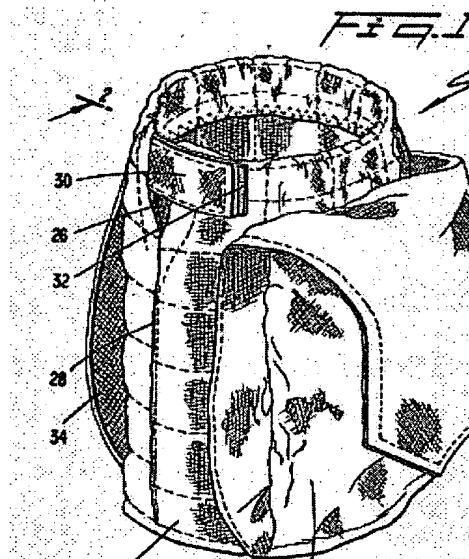


FIG. 1 of U.S. Patent No. 4,401,245 to Zills.

The carrier is comprised of an insulative jacket (12) having a longitudinal slit (26) formed adjacent to an upper end (18) of the jacket (12). A closure band (30) is provided. *See* FIGS. 1, 3-4, and 7. Zills fails to disclose, teach, or suggest modifying the beverage

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container carrier for use as a protective bat cover. Zills also fails to disclose the use of neoprene. As discussed in detail below, this reference is non-analogous to (and is far afield from) Appellant's claimed invention. There is no suggestion to pick and choose some of the features of Zills and combine them with other features picked and chosen by the Examiner from other diverse fields to arrive at the claimed combination of features for use in a protective bat cover.

2. U.S. Patent No. 4,989,811 to Millis *et al.* ("Millis").

U.S. Patent No. 4,989,811 to Millis *et al.* ("Millis") relates to a *holder for a baby bottle* which thermally insulates the bottle's contents and includes a strap and fastener by which the bottle and holder may be attached and hence secured to a nearby object. *See* col. 1, ll. 5-12.

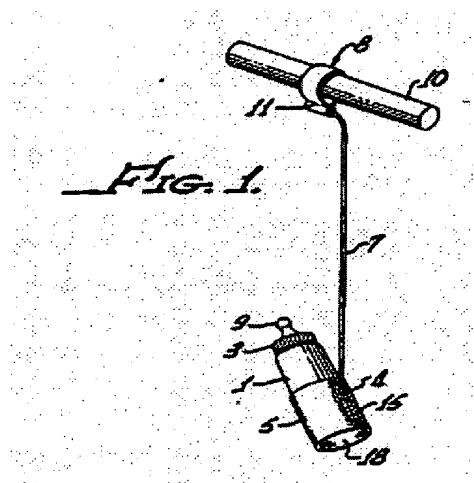


FIG. 1 of U.S. Patent No. 4,989,811 to Millis *et al.*

According to one embodiment, the holder may comprise a jacket (5) formed from a neoprene covered cloth. *See* col. 3, ll. 57+. Millis, however, discloses neither a split that extends into the open end of the jacket, nor a fastening mechanism located adjacent to the

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open end of the jacket. Similar to Zills above, Millis also fails to disclose, teach, or suggest modifying the holder for use as a protective bat cover. As discussed in detail below, this reference is also non-analogous to (and is far afield) from Appellant's claimed invention. There is no suggestion to pick and choose one or more of the features of Millis to be combined with other features picked and chosen by the Examiner, from other diverse fields, to arrive at the claimed combination of features for use in a protective bat cover.

3. U.S. Patent No. 5,163,608 to Block.

U.S. Patent No. 5,163,608 to Block is directed to a container insulator which can be unfolded so that it can be mailed as a postcard. *See* FIGS. 1-3. The combination postcard/container insulator (10) includes a substantially rectilinear sheet of flexible material (11) equipped with fastening means (12) so that the sheet (11) may be wrapped around the container (CT) and held in position as illustrated in FIG. 3. *See* col. 2, ll. 17-22.

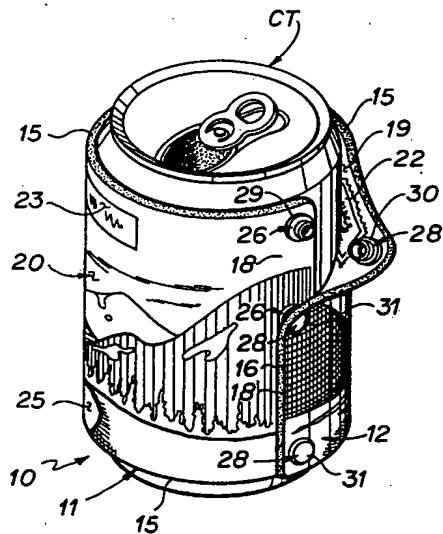


FIG. 3 of U.S. Patent No. 5,163,608 to Block.

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When attached to container (CT), the insulator (10) has two open ends, and thus fails to disclose at least one closed end. Further, the insulator of Block fails to disclose a split that extends into either of the open ends of insulator (10). Similar to Zills and Millis above, Block also fails to disclose, teach, or suggest modifying the holder for use as a protective bat cover. As discussed in detail below, this reference is also non-analogous to (and is far afield) from Appellant's claimed invention. There is no suggestion to pick and choose one or more of the features of Block to be combined with other features picked and chosen by the Examiner, from other diverse fields, to arrive at the claimed combination of features for use in a protective bat cover.

4. U.S. Patent No. 6,065,764 to Moseley.

U.S. Patent No. 6,065,764 to Moseley is directed to a *sanitary cover for a shopping cart handle*. In some embodiments, the cover may include a logo or graphic. See FIGS. 1-4.

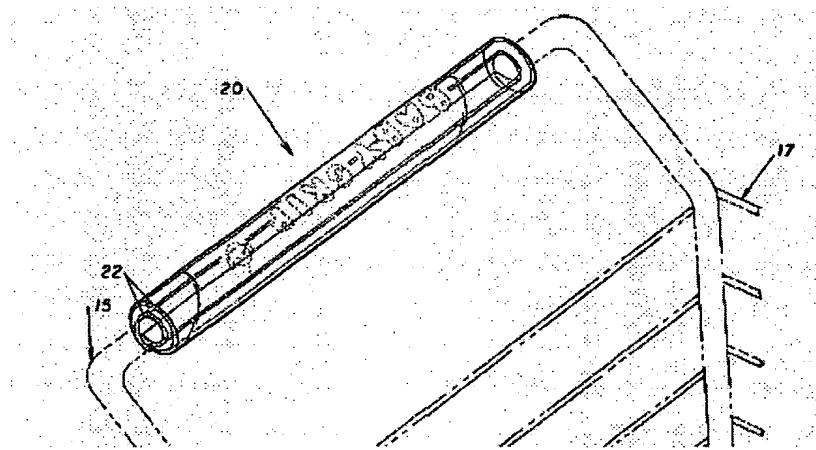


FIG. 2 of U.S. Patent No. 6,065,764 to Moseley.

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Moseley fails to disclose, teach, or suggest modifying the shopping cart handle cover for use as a protective bat cover. As discussed in detail below, this reference is non-analogous to (and is far afield from) Appellant's claimed invention. Additionally, there is no suggestion to pick and choose a feature of Moseley to be combined with other features picked and chosen by the Examiner, from other diverse fields, to arrive at the claimed combination of features for use in a protective bat cover.

B. The Examiner Relies on Non-Analogous Art for Each of Pending Claims 19 and 20

Independent claims 19 and 20 are pending. With regard to independent claim 19, the Examiner relies on Zills and Millis. With regard to independent claim 20, the Examiner relies on Zills, Millis, Block, and Moseley. The Examiner's reliance on Zills, Millis, Block, and Moseley is improper as these references are non-analogous art to Appellant's claimed invention.

A two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is "within the field of the inventor's endeavor." Second, assuming the reference is outside that field, it must be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986).

1. The references are outside Appellant's field of endeavor.

Zills, Millis, Block, and Moseley are outside the field of the inventor's endeavor for at least the reasons that none of these references relate to the relevant field of endeavor. The inventor's field of endeavor for each of independent claims 19 and 20 is a protective

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bat cover for bats. As such, there would be no reason one of ordinary skill in the art would look to the diverse fields of these references absent hindsight.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would be reasonably motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor... [I]t is...in other words, common sense...in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor...The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

Zills is directed to “a beverage container *carrier* that is insulated to maintain a constant beverage temperature and is foldable for compact storage.” *See* “TECHNICAL FIELD,” col. 1, ll. 5-10. *Emphasis Added.*

Millis “relates to a *holder* for a baby bottle which thermally insulates the bottle's contents and includes a strap and fastener by which the bottle and holder may be attached and hence secured to any nearby object...” *See* col. 1, ll. 5-12. *Emphasis Added.*

Block “relates generally to *container insulators* and more particularly to a container insulator which can be unfolded so that it can be mailed as a postcard.” *See* col. 1, ll. 6-9. *Emphasis Added.*

Moseley “relates to *sanitary shopping cart handle covers*.” *See* “BACKGROUND OF THE INVENTION,” col. 1, line 12. *Emphasis Added.*

These fields of endeavor are not within the inventor's field of endeavor. None are for protective bat covers.

2. The references are not reasonably pertinent to the particular problem(s) with which Appellant was involved.

Since Zills, Millis, Block, and Moseley are outside the inventor's field of endeavor, the inquiry becomes whether these references are reasonably pertinent to the particular problem(s) with which Appellant was involved. These problems included:

1. Increasing the life span of a bat by protecting the barrel of the bat with a cover constructed from a material having a greater resistance to harmful environmental elements. *See* pg. 2, ll. 11-13 of the Specification.
2. Protecting the barrel of a bat from harmful environmental conditions, as well as damage resulting from inadvertent contact with various other objects. *See* pg. 2, ll. 14-16 of the Specification.
3. Providing a cover for a bat to increase the range of temperatures in which the bat may be used without being damaged. *See* pg. 2, ll. 17-18 of the Specification.
4. Providing a cover for a bat made from material that can stretch, and that possesses a "memory-specific" nature so as to enable the cover to be easily secured to, and removed from bats. *See* pg. 3, ll. 7-11 of the Specification.
5. Providing a cover for a bat with a seam that extends only partially along the length of the cover, so as to form a split that facilitates the process of placing the cover on a bat. *See* pg. 8, ll. 14+ of the Specification.
6. Providing a cover for a bat having a fastening mechanism that facilitates placement of the cover on the bat, while enabling a relatively secure attachment to the bat. *See* pg. 3, ll. 12-14 of the Specification.

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7. Providing a cover for a bat that is adapted to maximize the visibility of various logos or graphics printed thereon. *See* pg. 3, ll. 15-19 of the Specification.
8. Providing a cover for a bat that is easy and cost-effective to manufacture. *See* pg. 6, ll. 14+ of the Specification.

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would commend itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve. If a reference disclosure has *the same purpose* as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992). **Emphasis Added.**

Zills, Millis, Block, and Moseley are more concerned with the problems of insulating beverage container carriers and baby bottle holders, and providing sanitary shopping cart handle covers. None of Zills, Millis, Block, and Moseley are reasonably pertinent to the particular problem(s) with which Appellant was involved.

A person having ordinary skill in the art would not reasonably have expected to solve the problem(s) of protecting the barrel portion of a bat by considering beverage container insulators, baby bottle holders, and sanitary shopping cart handle covers. The record is devoid of any evidence to the contrary.

For at least the foregoing reasons, Zills, Millis, Block, and Moseley are non-analogous to the claimed invention. Each of the rejections based thereon should therefore be withdrawn.

C. **Claims 19 and 20 are Patentable Under 35 U.S.C. §103(a)**

Assuming arguendo that the art addressed above is not deemed non-analogous, Appellant further submits that claims 19 and 20 are patentable for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a).

As stated in the MPEP § 2143, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). The requirements are: (1) the prior art must teach or suggest all the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings; and (3) there must be a reasonable expectation of success.

None of these requirements are met by the final rejections for the reasons set forth below.

All of the claim limitations must be taught or suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Suggestion or Motivation to modify the references

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

1. Claim 19 is Patentable Under 35 U.S.C. §103(a) over Zills in view of Millis.

Claim 19 is patentable over Zills in view of Millis. In the Office Action, at pg. 3, the Examiner alleges that the collapsible, insulative beverage container carrier of Zills meets all of the limitations of Appellant's claim 19, except for the material being neoprene. The Examiner relies on Millis, a baby bottle holder, for this feature.

The rejection of claim 19 is improper as there exists no teaching, suggestion, or motivation to modify the collapsible, insulative beverage container carrier of Zills to include the teachings of the baby bottle holder of Millis.

Assuming arguendo that there was a teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Zills and Millis, even when combined, fail to disclose, teach or suggest all of the elements of claim 19.

For example, the combination of Zills and Millis would yield a collapsible, insulative beverage container carrier having a jacket comprised of neoprene. There is no disclosure that teaches or suggests that the modified beverage container carrier of Zills comprises at least the following structural attributes of Appellant's protective bat cover, as claimed in claim 19:

“...wherein the substantially tubular casing further defines an interior cavity of substantially uniform diameter and is adapted to cover substantially only the barrel portion of the bat when the bat is inserted into the interior cavity such that an end of the barrel portion abuts the closed second end of the substantially tubular casing...”
Emphasis Added.

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Accordingly, the Examiner has failed to show how a collapsible, insulative beverage container carrier can be adapted to cover the barrel portion of a bat, and thus meet the structural attributes of Appellant's protective bat barrel cover, as disclosed and claimed in claim 19.

In addition, Appellant submits that the rejection of claim 19 is improper as the Examiner has failed to accord any patentable weight to the preamble of claim 19.

In the Office Action, at pg. 3, the Examiner recites:

With respect to the cover being used for a baseball or softball, to the degree the bat is not claimed, the cover in Zills, as modified by Millis, meets all claimed limitations. Furthermore, it is regarded as an intended use, and the claimed cover does not impart any structure over the structure in Zills.

Appellant disagrees. It is quite clear from this passage that the Examiner has failed to accord any patentable weight to the preamble of claim 19, or to the required claim limitation that the cover is adapted to cover substantially only the barrel portion of the bat when the bat is inserted into the interior cavity such that an end of the barrel portion abuts the closed second end of the substantially tubular casing.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

The preamble of claim 19 positively recites, in part, that Appellant's claimed invention is a protective bat barrel cover for a bat. The preamble of claim 19 further sets

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forth characteristics of a baseball/softball bat that the protective bat barrel cover protects (*e.g.*, a bat having a barrel portion and a handle portion, wherein the diameter of the handle portion is less than the diameter of its barrel portion). Subsequent claim limitations refer back to the recitation of a bat. Reading the preamble of claim 19 in context of the entire claim makes it evident that Appellant's invention is a protective bat barrel cover intended to encompass covers for baseball or softball bats, and that the cover is adapted as such. It is legal error to ignore this plethora of limitations in both the preamble and body of the claim relating to a bat.

The Examiner's reliance on Zills and Millis fails to establish a *prima facie* case of obviousness. There is no suggestion to combine the references. Even if there was a suggestion to combine the references, the combination is missing at least one claim element, and the Examiner studiously ignores other limitations of the claim, recognizing that the claimed combination of features does not exist in the protective bat cover art.

For *at least* these reasons, in addition to the non-analogous art arguments as set forth in detail above, claim 19 is patentable over the combination of Zills in view of Millis. As such, the rejection of claim 19 is legally improper and should be withdrawn.

2. *Claim 20 is Patentable Under 35 U.S.C. §103(a) over the combination of Zills and Millis, further in view of either Block or Moseley.*

Claim 20 is patentable over the combination of Zills and Millis, further in view of Block. Claim 20 is also patentable over the combination of Zills and Millis, further in view of Moseley.

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In the Office Action, at pg. 3, ¶4, the Examiner concedes that combination of Zills and Millis fails to teach a graphic displayed on the cylindrical sleeve. To address this one particular feature, the Examiner relies on either the combination postcard/container insulator of Block, or the sanitary shopping cart handle cover disclosed in Moseley.

a. The combination of Zills and Millis.

The rejection of claim 20 is improper *at least* because the combination of Zills and Millis is deficient for the reasons set forth in detail above regarding claim 19.

b. Zills and Millis, further in view of either Block or Moseley.

The rejection of claim 20 is further legally improper because the Examiner has relied on two combinations of three different references (Zills, Millis, & Block -and- Zills, Millis, & Moseley), each from diverse arts and directed to diverse problems, without any legally proper basis for combining the references. This is a classic exercise in the art of “20-20” hindsight.

Applicant understands that patent examination is necessarily conduct by hindsight, with complete knowledge of the applicant's invention. Courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the invention. The combination of elections from non-analogous sources, in a manner that reconstructs the applicants' only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

For the rejection of claim 20, the Examiner has sought to modify an already improper combination of a beverage container carrier (Zills) and a baby bottle holder and insulator (Millis), with either a combination postcard/container insulator (Block) or a shopping cart handle cover (Moseley). This is improper.

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Appellant submits that there is no suggestion or motivation to further modify the improper combination of Zills and Millis, to include a graphic as taught by Block or Moseley, as neither Zills nor Millis appear to be concerned with the feature of prominently displaying a team name, company name, team logo, graphic, or other design, especially in instances when the improper beverage container insulator/baby bottle holder combination is being viewed from a distance.

Selectively picking and choosing among the many disclosed elements of Zills, Millis, Block, and Moseley for no other reason than to reconstruct Appellant's invention constitutes impermissible hindsight.

For *at least* these reasons, in addition to the non-analogous art arguments as set forth in detail above, Appellant submits that claim 20 is patentable over the combination of Zills and Millis, further in view of either Block or Moseley. The rejection of claim 20 is legally improper and should be withdrawn.

VIII. CLAIMS APPENDIX - 37 C.F.R. §41.37(c)(1)(viii)

The pending claims (claims 19 and 20) are attached in the Appendix.

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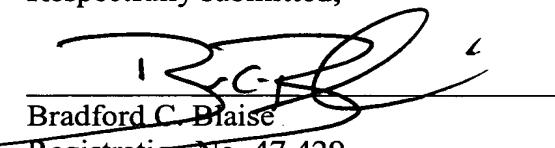
CONCLUSION

For at least the foregoing reasons, Appellant respectfully requests that the rejection of claims 19 and 20 on all grounds be reversed.

Date: January 12, 2005

Respectfully submitted,

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CLAIMS APPENDIX

19. *(Previously Presented)* A protective bat barrel cover for a baseball or softball bat having a barrel portion and a handle portion, wherein the barrel portion is substantially uniform in diameter, and wherein the diameter of the handle portion is less than the diameter of the barrel portion, the protective bat barrel cover comprising:

 a first piece of neoprene material having a first edge and an opposing second edge fastened together to form a substantially tubular casing having a first open end for receiving the barrel portion of the bat, and a second end closed off by a second piece of neoprene material fastened to the first piece of neoprene material;

 wherein the first edge and opposing second edge of the first piece of neoprene material are fastened together only partially along their respective lengths to form a split that begins nearest to and extends into the first open end of the substantially tubular casing;

 wherein the substantially tubular casing further defines an interior cavity of substantially uniform diameter and is adapted to cover substantially only the barrel portion of the bat when the bat is inserted into the interior cavity such that an end of the barrel portion abuts the closed second end of the substantially tubular casing; and

 fastening means mounted on the substantially tubular casing adjacent to the open end for securing the cover to the barrel portion of bat.

20. (*Previously Presented*) A protective bat barrel cover for a baseball or softball bat having a barrel portion and a handle portion, wherein the barrel portion is substantially uniform in diameter, and wherein the diameter of the handle portion is less than the diameter of the barrel portion, the protective bat barrel cover comprising:

 a first piece of elastic rubber material having a first edge and an opposing second edge fastened together to form a substantially tubular casing having a first open end for receiving the barrel portion of the bat, and a second end closed off by a second piece of elastic rubber material fastened to the first piece of elastic rubber material;

 wherein the first edge and opposing second edge of the first piece of elastic rubber material are fastened together only partially along their respective lengths to form a split that begins nearest to and extends into the first open end of the substantially tubular casing;

 wherein the substantially tubular casing further defines an interior cavity of substantially uniform diameter and is adapted to cover substantially only the barrel portion of the bat when the bat is inserted into the interior cavity such that an end of the barrel portion abuts the closed second end of the substantially tubular casing;

 fastening means mounted on the substantially tubular casing adjacent to the open end for securing the cover to the barrel portion of the bat; and

 a graphic displayed on the substantially tubular casing between the closed end and the fastening means.